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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/718,781

11/20/2003

Christopher J. Burt

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EXAMINER

LUBIN, VALERIE

ART UNIT

PAPER NUMBER

3626

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/718,781	<b>Applicant(s)</b> BURT ET AL.	
	<b>Examiner</b> VALERIE LUBIN	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/13/06, 05/24/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>EAST search history</u> .              |

## **DETAILED ACTION**

### ***Acknowledgement***

1. Claims 1-39 are pending

For reference purposes, the document paper number is 20080708

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 15 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The language of claim 15 is unclear, as Examiner cannot ascertain what Applicant means by "...of a counter of the plurality..." An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed (In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989)).

5. For claim 34, is it unclear what Applicant means by "generic".

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boukobza et al., U.S. Patent No. 6,122,664 in view of Shipon, U.S. Pre-Grant Pub No. 2003/0023459.

8. With respect to claim 1, Boukobza recites a method comprising the steps of monitoring one or more performance parameters of a system by recording the values of the parameters by one of a plurality of counters; comparing the value of the counters to thresholds (Abstract, column 2, lines 50-52; column 32, lines 10-11).

Boukobza recites measuring health indicators (Column 9, lines 23-26), but he does not specifically disclose a healthcare information system. However, Shipon discloses a healthcare information system (§ 52). It would therefore have been obvious to one of ordinary skill in the art to combine the teachings of Boukobza and Shipon to measure performance parameters of a healthcare system in order to ensure that the system is operating properly.

Boukobza recites notifying a user of a problem (Column 17, 58-67; column 32, lines 17-20). A predictable result of Boukobza would therefore be to notify a representative for any abnormal observation of parameters (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)). Furthermore, the limitation of "notifying a designated representative if..."

is optional language, and according to the MPEP, “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation” (2106.II.C).

Claim 15 is rejected under the analysis of claim 1.

9. Concerning claim 2, Boukobza discloses taking measurements at predetermined intervals (Column 6, lines 64-66).

10. For claims 3-5, the type of parameters being measured is non-functional descriptive material that does not further limit the process steps found in claim 1, i.e. monitoring, comparing and notifying (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II). Therefore, claims 3-5 are rejected under the analysis of claim 1.

11. Claims 6-10 are rendered obvious, as Boukobza recites notifying a management system (Column 18, lines 58-67) and notifying an administrator of the monitored application (Column 32, lines 17-20). A predictable result of Boukobza would therefore be to notify any necessary device, system or person in order to have the application or system repaired (KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007)).

Claims 26-30 are rejected under the analysis of claims 6-10.

12. Claims 11 and 12 are also rejected, as Boukobza recites a user defining thresholds (Column 9, line 67; column 10, lines 1-4, 23-26).

Claims 31 and 32 are rejected under the analysis of claims 11 and 12.

13. With respect to claim 13, Boukobza discloses receiving an acknowledgement of receipt of the notification, an instruction of an action to be performed, and performing the action (Column 17, lines 62-67; column 18, lines 4-7).

14. Claim 14 is an optional limitation which is not required to be performed, and therefore does not further limit the process of claim 13. Claim 14 is therefore rejected under the analysis of claim 13.

15. Claim 16 is rendered obvious over Boukobza who recites determining a numerical value for performance parameters (Column 15, lines 10-12; column 27, lines 64-65).

Claim 35 is rejected under the analysis of claim 16.

16. Regarding claim 17, Boukobza discloses displaying a user interface to show parameter curves, conditions, actions and later analysis (Column 3, lines 60-67; column 4, lines 1-4). Therefore, claim 17 is rendered obvious over the prior art.

Claim 36 is rejected under the analysis of claim 17.

Claim 37 is also rejected under the analysis of claim 17, as it recites a duplicated component and it has been held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced (*In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960)).

17. Claim 18 is rejected, as Boukobza recites a system comprising a plurality of modules to measure performance parameters and one or more autonomous agents (Abstract).

Claim 34 is rejected under the analysis of claim 18.

Claims 38 and 39 are also rejected under the analysis of claim 18.

18. With regards to claim 19, Boukobza discloses an operator capable of taking action (Abstract; column 2, lines 46-52).

Claims 20 and 21 are rejected under the analysis of claim 19.

19. For claim 22, Boukobza discloses taking measurements at predetermined intervals (Column 6, lines 64-66).

20. For claims 23-25, the type of parameters being measured is non-functional descriptive material that does not further limit the system found in claim 18 (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II). Therefore, claims 23-25 are rejected under the analysis of claim 18.

21. Claim 33 is an optional limitation which is not required to be performed, and therefore does not further limit claim 18. Claim 33 is therefore rejected under the analysis of claim 18.

***Conclusion***

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295. The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher L. Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VL

/C Luke Gilligan/  
Supervisory Patent Examiner, Art Unit 3626